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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,590	02/08/2002	Dale F. McIntyre	83782F-P	2698

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EXAMINER
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ALI, MOHAMMAD

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/071,590

Applicant(s)

MCINTYRE ET AL.

Examiner

Mohammad Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to the Election filed on 02/24/2005.

Applicant's elected Group I (claims 1-11 and 16) without traverse. Group I should be consisting of claims 1-11 and 14-16 and Examiner treat as in one group of those claims.

The application has been examined and claims 1-16 are pending in this Office Action.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "A method" in claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**MPEP 2106 IV.B.2.(b)**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claim 1, in view of the above-cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Theses claim do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. The use of a computer is not evident in the claim. MPEP 2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded on it."

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-11, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houchin et al. ('Houchin' hereinafter), USP 5,983,229 in view of Parks et al. ('Parks' hereinafter), USP 5,025,396.

With respect to claim 1,

Houchin discloses a method for automatically updating non-image data stored at a first storage location using a first image application, said non-image data being associated with a digital image of a user (see col. 2, lines 18-26), comprising the steps of:

providing new information with respect to said digital image in a second image application same (see col. 1, lines 5-11); and

automatically updating said non-image data at said first storage location with respect to said information (see col. 2, lines 54-56, Fig. 1).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

As to claim 2,

Houchin teaches wherein said second image application further comprises an application for the production of an image product (see col. 2, lines 18-26).

As to claim 3,

Houchin teaches wherein said second image application runs on a computer which is associated with said first storage location (see col. 3, lines 36-39, Fig. 2 et seq).

As to claim 4,

Houchin teaches wherein said non-image data and said digital image are stored at said first storage location (see col. 3, lines 66-66, Fig. 3 et seq).

As to claim 5,

Houchin teaches wherein said non-image data is contained within said digital image (see col. 3, lines 66-66, Fig. 3 et seq).

As to claim 6,

Houchin teaches wherein said provided information is used to update said non-image data associated with a group of said digital images of a user (see col. 4, lines 10-15, Fig. 3 et seq).

As to claim 7,

Houchin teaches wherein said group of said digital images comprises an album page and said provided non-image information is provided with respect to a feature of the album page (see col. 3, lines 66-66, Fig. 3 et seq).

With respect to claim 8,

Houchin discloses a method for automatically updating non-image data stored at a first location, said information being associated with a digital image of a user (see col. 2, lines 18-26), comprising steps of:

providing at least one digital image of a user to a remote image server (see col. 1, lines 5-11);

said user granting access to at least one third party to said at least one digital image stored at said remote image server (see col. 1, lines 5-11 and Abstract);

said third party providing information with respect to said at least one digital image using an image application running at said remote site (see col. 1, lines 5-11);  
and

automatically updating said non-image data with said information (see col. 2, lines 54-56, Fig. 1).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

As to claim 9,

Houchin teaches wherein the step of said third party providing information with respect to said at least one said digital image further comprises providing comments with respect to a photo album stored at said remote site (see col. 3, lines 66-66, Fig. 3 et seq).

With respect to claim 10,

Houchin discloses a method for updating non-image data stored at a first location, said information being associated with a digital image of a user (see col. 2, lines 18-26), comprising steps of:

providing at least one digital image of a user to a remote image server (see col. 1, lines 50-51 et seq);

said user granting access to at least one third party to said at least one digital image stored at said remote image server (see col. 2, lines 63-67 et seq);



said third party providing information with respect to said at least one digital image in an image application running at said remote image server (see col. 3, lines 66-66 and Abstract, Fig. 3 et seq);

notifying said user of the existence of said information with respect to said at least one digital image (see col. 3, lines 66-66, Fig. 3 et seq); and

automatically updating said non-image data with said information if said user decides to do so (see col. 4, lines 10-15, Fig. 3 et seq).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

With respect to claim 11,

Houchin discloses a method for updating non-image data associated with digital images of a user stored at a first storage location (see col. 2, lines 18-26), comprising the steps of:

granting access to said digital images stored at said first location to at least one third party (see col. 2, lines 63-67, Fig. 3 et seq);

transferring at least one of said digital images from said first storage location to said third party's computer over a communication network (see col. 1, lines 50-51 et seq);

said third party providing information with respect to said at least one digital image in an image application running on said third party's computer (see col. 1, lines 50-51 et seq);

notifying said user over said communication network of the existence of said information with respect to said at least one digital image (see col. 3, lines 66-66, Fig. 3 et seq); and

updating said non-image data stored at said first storage location with said information if said user decides to do so (see col. 4, lines 10-15, Fig. 3 et seq).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

As to claim 14,

Houchin teaches wherein said computer is located remote from said first storage location (see col. 4, lines 10-15, Fig. 3 et seq).

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As to claim 15, Houchin teaches wherein said first storage location comprises a computer of said user and said remote computer comprises that of a third party (see col. 4, lines 10-15, Fig. 3 et seq).

Claim 16 has same subject matter as of claims 8 and 10 and essentially rejected for the same reasons as discussed above.

***Remarks***


6. Combination of references teaches all the limitations as stated above.

***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (571) 272-4105. The examiner can normally be reached on Monday-Thursday (7:30 am-6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mohammad Ali  
Primary Examiner  
Art Unit 2167

MA  
May 4, 2005